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Attorney Docket No. 10139/06302 (00005-05PUS1)

REMARKS

Claims 1-33 have been cancelled. Claims 35 - 44, 50, 51 and 56 have been amended to more particularly point out and distinctly claim the invention and the specification has been amended to correct typographical errors. No new matter has been added. Claims 34 - 60 remain pending in the present application. In view of the above amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are in condition for allowance.

The disclosure stands objected to as including a typographical error in ¶ 10. In view of the above amendments to the specification, it is respectfully requested that this objection be withdrawn.

Claim 51 stands rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In view of the above amendments, it is respectfully submitted that all of the presently pending claims fully comply with §112 and it is requested that this rejection be withdrawn.

Claims 34 - 52 and 54 - 60 stand rejected under 35 U.S.C. §103(a) as unpatentable over Burkinshaw (U.S. Patent 6,551,321) in view of Brumback (U.S. Patent 6,120,504) and Hover (U.S. Patent 6,296,645).

Claim 34 recites an intramedullary nail comprising "a nail body having a longitudinal axis, a proximal end configured and dimensioned for coupling to an insertion device, and a distal end having a tip configured and dimensioned for insertion into the intramedullary canal of a long bone" in combination with "at least three transverse holes extending through the distal end of the nail body, each transverse hole defining a hole axis, and all three transverse holes grouped at the distal end within a distance x measured from the tip of the nail body to the axis of the transverse hole furthest from the tip, wherein a projection of the three hole axes of the at least three transverse holes in a plane orthogonal to the longitudinal axis is such that at least two of the projected hole axes are at an angle α with respect to one another, where $0 < \alpha < 90^\circ$, and *where the distance $x \leq 25d$, where d is either the diameter of the largest of the at least three transverse holes or d is the mean diameter of the at least three holes.*"

Attorney Docket No. 10139/06302 (00005-05PUS1)

It is respectfully submitted that the Examiner has tacitly admitted that none of the cited references shows or suggests a distance x between the tip and a furthest hole axis $\leq 25d$ "*where d is either the diameter of the largest of the at least three transverse holes or d is the mean diameter of the at least three holes,*" as recited in claim 34. Specifically, to show this claim element, the Examiner has relied solely on measurements of Fig. 6 of Burkinshaw which he concedes does not state that its drawings are to scale and which is silent as to dimensions. The MPEP specifically states that "arguments based on measurements of the drawing features are of little value." (MPEP § 2125). "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." Hockerson-Halberstadt, Inc. v. Avia Group, Int'l., 222 F.3d 951, 956 (Fed. Cir. 2000) (quoted in MPEP § 2125).

Further, the Examiner also concedes that Burkinshaw does not specifically teach the holes being within 25 hole-diameters from the tip ($x \leq 25d$), nor does Burkinshaw show or suggest a range for the hole diameter. The Examiner goes on to state that "[i]t would have been obvious to use a known screw, having 4.5 mm as the outer diameter, in the invention of Burkinshaw et al., since one would have chosen from among suitable diameters for screws in the art as such as the one suggested by Hover et al." It is respectfully submitted that this speculation necessitates the further speculation that any change in screw diameter would not have resulted in further changes to the placement of the screw holes the positions of which are already so imperfectly established in the Examiner's rejection.

Thus, it is respectfully submitted that the Examiner's rejection constitutes an improper hindsight reconstruction of the invention and that none of the cited references either shows or suggests "*at least three transverse holes in a plane orthogonal to the longitudinal axis ...are at [a]...distance $x \leq 25d$, where d is either the diameter of the largest of the at least three transverse holes or d is the mean diameter of the at least three holes,*" as recited in claim 34 and that this claim is allowable over Burkinshaw, Brumback and Hover taken either alone or in combination.

Since claims 35 - 44 depend from and, therefore, include all the limitations of claim 34, it is respectfully submitted that these claims are also allowable for at least the reasons stated above.

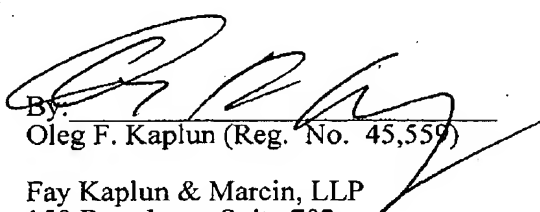
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Similarly, claim 45 recites an intramedullary nail comprising a nail body having a longitudinal axis, a proximal end configured and dimensioned for coupling to an insertion device, and a distal end having a tip configured and dimensioned for insertion into the intramedullary canal of a long bone, at least three transverse holes extending through the distal end of the nail body, each transverse hole defining a hole axis, and all three transverse holes grouped at the distal end within a distance x measured from the tip of the nail body to the axis of the transverse hole furthest from the tip, wherein a projection of the three hole axes of the at least three transverse holes in a plane orthogonal to the longitudinal axis is such that at least two of the projected hole axes are at an angle α with respect to one another, where $0 < \alpha < 90^\circ$, and where the distance $x < 2(n)(d)$, where n is the number of transverse holes grouped within the distance x from the tip of the nail body and d is either the diameter of the largest of the at least three transverse holes or d is the mean diameter of the at least three holes.

Regarding independent claims 45 and 56, the Examiner uses same rejections as that above, particularly the Examiner relies on drawing that are not to scale to show particular sizes. Thus it is respectfully submitted that these claims, and claims 46 - 55 and 57 - 60 depending therefrom are also allowable for at least the reasons stated above.

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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